

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Number	: 6,891,094	Confirmation No.:	3539
Reexamination No.	: <i>Ex Parte</i> Request Pending		
Inventor/Patentee	: Geoffrey McCabe		
Issue Date	: May 10, 2005		
Title	: Tuning Means for Stringed Musical Instrument		
TC/Art Unit	: 2837		
Examiner:	: Kimberly R. Lockett		
Docket No.	: McCabe-1		
Customer No.	: 87,045		

**NOTIFICATION OF EXISTENCE OF PRIOR PROCEEDING
AND DECISION THEREON PURSUANT TO 37 CFR § 1.565**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Patentee, Geoffrey McCabe, hereby informs the United States Patent & Trademark Office (PTO) pursuant to 37 CFR § 1.565 that the validity of the above-captioned '094 patent was previously at-issue in International Trade Commission (ITC) Investigation No. 337-TA-586, which was commenced on October 3, 2006, and terminated on May 16, 2008. *See In re Certain Stringed Musical Instruments and Components Thereof*, Inv. No. 337-TA-586, 71 Fed. Reg. 64738 (Nov. 3, 2006). During that investigation, the Investigative Staff of the ITC found claims 1, 14-18, and 20-22 of the '094 patent infringed, enforceable, and **valid** (i.e., not anticipated nor rendered obvious) in view of U.S. Patent No. 4,672,877 to Hoshino, *et al.* ("Hoshino '877"). *See* Commission Investigative Staff's Posthearing Brief, ITC Investigation No. 337-TA-586, page 28, *et seq.* (August 31, 2007). The Investigative Staff (otherwise known as the ITC's Office of Unfair Import Investigations (OUII) Staff) serves as an independent third party representing the public interest in an ITC investigation. A courtesy copy of the Commission Investigative Staff's Posthearing Brief is enclosed herewith along with copies of the Commission Investigative Staff's Proposed Findings of Fact and Conclusions of Law and The Commission Investigative Staff's Posthearing Reply Brief from that same ITC investigation. Patentee respectfully requests entry of these official and publicly available ITC documents into the record of the above-captioned patent.

On December 7, 2010, third party Floyd Rose Marketing, Inc. requested an *ex parte* reexamination of claims 1, 14-18, and 20-22 of the '094 patent in view the Hoshino '877 patent. Particularly, Floyd Rose Marketing alleges that claims 1, 14, and 22 are anticipated by the Hoshino '877 patent, or in the alternative, claims 1, 14-18, and 20-22 are obvious over the Hoshino '877 patent taken in combination with U.S. Patent No. 4,967,631 to Rose and/or U.S. Patent No. 4,882,967 to Rose. While the PTO has not yet decided whether to grant this *ex parte* reexamination request, Patentee respectfully notes that the Investigative Staff of the ITC has already concluded that claims 1, 14-18, and 20-22 are not anticipated nor rendered obvious by the Hoshino '877 patent. *See id.* In other words, the alleged substantial new questions of patentability raised by Floyd Rose Marketing in its reexamination request include the very same arguments that Floyd Rose Marketing proffered during ITC Investigation No. 337-TA-586 – arguments that the Investigative Staff considered and concluded to be without merit.¹ *See id.*

Floyd Rose Marketing's reexamination request was prompted by the Patentee's patent infringement, false marking, and unfair competition lawsuit brought against, among others, Floyd Rose Marketing in federal district court. *See McCabe vs. Floyd Rose Guitars*, Case No. 3:10-cv-00581-W-JMA, U.S. District Court for the Southern District of California. A courtesy copy of Patentee's complaint in that lawsuit is enclosed herewith. Floyd Rose Marketing has moved for a stay of that lawsuit in view of its reexamination request. Patentee respectfully submits that Floyd Rose Marketing's pending reexamination request is without merit and an attempt to delay fact discovery pertaining to patentee's false marking and unfair competition claims against Floyd Rose Marketing.

No fee is believed to be due in connection with the present Notification. In the event that a fee is required to enter this Notification or any questions arise concerning the subject matter of this Notification, the PTO is invited to contact the undersigned to address such.

Respectfully submitted,

SAN DIEGO IP LAW GROUP LLP

Dated: January 7, 2011

By: /Trevor Q. Coddington/

¹ ITC Investigation No. 337-TA-586 named Floyd Rose Guitars as a Respondent rather than Floyd Rose Marketing, Inc. However, in the past, Floyd Rose Marketing, Inc. has done business as Floyd Rose Guitars and therefore the two entities are one in the same.

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